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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,673	07/03/2003	Jeffrey N. Ebberts	05-00110-07	7333

20491 7590 09/06/2005

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EXAMINER	
DELCOTTO, GREGORY R	

ART UNIT	PAPER NUMBER
1751	

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/613,673	EBBERTS, JEFFREY N.	
	Examiner	Art Unit	
	Gregory R. Del Cotto	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 June 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) *13-22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12 and 23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *7/3/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-23 are pending.

Applicant's election of Group I, claims 1-12 in the reply filed on 6/10/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 13-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6/10/05.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-12 arerejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claims 9 and 11, the specification, as originally filed, provides no basis for "about" with respect to the upper limits of the first carbonate salt, the first bicarbonate or percarbonate salt, the first acid, the second carbonate salt, the second bicarbonate or percarbonate salt, and the second acid. This is deemed as new matter.

Claims 10 and 12 have been rejected due to their dependency on claims 9 and 11, respectively.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-12 and 23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ebberts (US 6,126,697) or Harris et al (US 5,244,468).

Ebberts teaches carpeting, upholstery, drapery, and other textile fibers are cleaned by applying to the fibers, from a pressurized container, an aqueous internally carbonated non-surfactant cleaning compositions prepared by admixing, by volume about 125 ml of an alkaline metal bicarbonate or percarbonate salt, about 62.5 ml of a carbonate salt, and about 187.5 ml of a natural solid acid, in an aqueous medium such that the natural solid acid reacts with the carbonate/bicarbonate salts to produce carbon dioxide and the solids concentration in the solution resulting from the carbonate salts and natural solid acid forms the basis of the cleaning solution. See Abstract. Additionally, other acids may be used in the composition including succinic acid, tartaric acid, adipic acid, oxalic acid, etc. See column 4, lines 45-69.

Specifically, Ebberts claims a self-carbonate, aqueous, non-surfactant, non-mmonic based cleaning composition containing 187.5 of a solid acid which may be citric acid, about 62.5 ml of an alkaline carbonate salt, and about 125 ml of an alkaline metal bicarbonate or percarbonate salt, in an aqueous medium such that the solid acid reacts with the alkaline salt mixture to produce carbon dioxide and the solids concentration in the solution is between about 1% to 5% by volume. See claim 1 and Example 5. Note that, with respect to the pH of the composition as recited by the instant claims, the Examiner asserts that the pH of the compositions as specifically taught by Ebberts would inherently have the same pH as the composition recited by the instant claims because Ebberts teaches compositions containing the same components in the same proportions as recited by the instant claims.

Harris et al teach carpeting, upholstery, drapery and other textile fibers which are cleaned by applying to the fibers, from a pressurized container, an aqueous effervescing internally carbonated non-detergent cleaning composition prepared by admixing, in percent by weight about 20 to 60% of a carbonate salt, about 20 to 60% of a natural solid acid, and 5 to 40% urea in an aqueous medium such that the natural solid acid reacts with the carbonate salt to produce carbon dioxide and the solids concentration in the solution resulting from the carbonate salt, natural solid acid and urea is between about 0.5 and 10% by weight. See Abstract.

Specifically, Harris et al teach a mixture of 100 g of sodium citrate dihydrate, 131 g of sodium carbonate, 100 g of sodium borate, 19.25 g of urea, and 48.74 g of citric acid was added to 4 gallons of water. The pH was 9.5 before carbonation and 7 after carbonation. See column 8, lines 45-55. Note that, the carbonate salt may be sodium carbonate, sodium percarbonate, sodium bicarbonate, etc. See claim 2.

Note that, claim 1 is a product by process claim; even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. Once a product appearing to be substantially identical is found a 35 USC 102/103 rejection is made, the burden shifts to the applicant to show an unobvious result. See MPEP 2113.

The Examiner asserts that the compositions as taught Ebberts or Harris et al would inherently have the same properties as the compositions recited by the instant claims because Ebberts or Harris et al teach compositions containing the same components in the same proportions as recited by the instant claims. Ebberts or Harris et al disclose the claimed invention with sufficient specificity to constitute anticipation. Accordingly, the teachings of Ebberts or Harris et al anticipate the material limitations of the instant claims.

Alternatively, even if the broad teachings of Ebberts or Harris et al are not sufficient to anticipate the material limitations of the instant claims, it would have been nonetheless obvious to one of ordinary skill in the art to formulate a composition having the same properties as recited by the instant claims because Ebberts or Harris et al teach that the types and amounts of components added to the composition may be varied.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Harris (5,718,729).

'729 teaches carpeting, upholstery, drapery and other textile fibers are cleaned by applying to the fibers, at ambient pressures, an aqueous, chemically carbonated cleaning composition prepared by admixing a carbonate salt solution, and an acid solution, such that the acid reacts with the carbonate salt to produce carbon dioxide coincident with application to a textile to be cleaned. Citric acid and sodium carbonate are the preferred acid and carbonate salt. See Abstract. The term carbonate salt shall mean a member selected from the group consisting of sodium carbonate, sodium

perchlorate, sodium bicarbonate, etc. Mixtures of sodium carbonate and sodium bicarbonate are preferred. See column 5, lines 45-65.

Specifically, '729 teaches a method of cleaning textile fibers which comprises applying to said fibers, an internally-carbonating cleaning composition at ambient pressure and at an elevated temperature of at least 140 degrees Fahrenheit, said composition being prepared coincident with said application by combining solutions, consisting essentially of an aqueous carbonate salt solution comprising 0.1 to 16% by weight of a carbonate salt, said carbonate solution having a pH of between about 8 and 11; and an aqueous acidic solution comprising 0.1 to 16% by weight of an acid, said acidic solution comprising an acid having a pH of between about 3 and 6 wherein the relative proportions of carbonate salt, and acid are such that the carbonate reacts with the acid when said solutions are combined so as to create an aqueous composition having a generally neutral pH. See claim 1. Further, the acid solution is buffered bya carbonate salt to a pH of between about 3 and 6 and said carbonate salt solution is buffered by an acid at a pH of between about 8 and 11 prior to said coincident preparation and application of said composition to textile fibers. See claim 9. '729 discloses the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of '729 anticipate the material limitations of the instant claims.

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris (US 5,718,729).

Harris is relied upon as set forth above. However, Harris does not teach, with sufficient specificity, a composition containing the requisite components in the specific proportions of components as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition containing the requisite components in the specific proportions of components as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Harris suggests a composition containing the requisite components in the specific proportions of components as recited by the instant claims.

Claim 23 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Harris (US 5,718,729).

Harris is relied upon as set forth above. Note that, the Examiner asserts that the compositions as specifically disclosed by Harris would inherently have the same solids content as recited by instant claim 23 because these compositions contain the same components in the same proportions as recited by the instant claims. Harris discloses the claimed invention with sufficient specificity to constitute anticipation.

Accordingly, the teachings of Harris anticipate the material limitations of the instant claims.

Alternatively, even if the broad teachings of Harris are not sufficient to anticipate the material limitations of the instant claims, it would have been nonetheless obvious to one of ordinary skill in the art to arrive at the claimed solids content of the composition

in order to provide the optimum cleaning properties to the composition since Harris teaches that the amount of required components added to the composition may be varied.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12 and 23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,126,697. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-9 of US Pat. 6,126,697 encompass the material limitations of the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a self-carbonated nonsurfactant, non-ammonic based cleaning solution having the specific pH containing an acid, alkaline agent, and other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success, because claims 1-9 of US Pat.

6,126,697 suggest a self-carbonated nonsurfactant, non-ammonic based cleaning solution having the specific pH containing an acid, alkaline agent, and other requisite components of the composition in the specific proportions as recited by the instant claims.

Conclusion

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.

Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory R. Del Cotto
Primary Examiner
Art Unit 1751

GRD
August 30, 2005